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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,634	12/02/2003	Andrew J. Callinan	58876US002	4534

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EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 09/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/725,634	Applicant(s) CALLINAN ET AL.	
	Examiner Daniel Zirker	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/02/03 & 3/21/05</u> . | 6) <input type="checkbox"/> Other: ____ |

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1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 11-18, 25, 26, 29-37, 46, and 49 are rejected under 35 U S C 112, 1st paragraph as each being claims which fail to have a corresponding supporting disclosure present within applicants' disclosure. For example, the "Static Angle Test" referred to on page 26 of the specification is nowhere described in the application and the document referred to by applicants which presumably contains such an enabling disclosure thereof is also not believed to be suitably described; it is believed that claims 25, 26, 46 and 49 recite parameters taken from this test but unfortunately applicants' specification clearly appears to be non enabling on this particular issue. The remaining rejected claims are also believed to lack a suitable corresponding disclosure in the specification, which should be amended to include same.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1, 4, 7-10, 29, 36 and 37 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Howard. Note particularly the Abstract, Col 1, line 28- Col 2, line 15, Claim 1. The reference discloses a repositionable acrylate adhesive composition, coated articles and methods of making the adhesive wherein the adhesive may simply be a plurality of cationic microspheres immersed in a film forming binder, which is substantially all that at least the majority of these claims require. As to claims 9 and 37, the absence of adhesive residue is believed to be either inherent, or alternatively an obvious modification to one of ordinary skill.

6. Claims 1-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard combined with Crandall et al. Howard is again relied upon substantially as set forth, above, while Crandall et al discloses (note particularly the Abstract, Col 1, lines 10-19, Col 3, line 43 – Col 4, line 37, Col 6, line 59 – Col 9, line 54, Col 10, lines 26 – 36, Examples) what essentially appears to comprise applicants' broad genus of cationic adhesive microspheres that are suitable for forming the claimed genus of repositionable adhesive compositions, together with the accompanying methods of making and using, various adhesive compositions, coated articles and the like. The references are clearly combinable, each featuring repositionable adhesive compositions which feature cationic microspheres, with the microspheres of Crandall et al improving the adhesive compositions of Howard by incorporating their microspheres in place of the Howard microspheres, motivated by (Col 3, lines 44 – 47) an expectation of enhanced stability and performance properties, while maintaining inherent tackiness, elastomeric

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properties and solvent or water dispersibility. Other parameters that are not either expressly or inherently disclosed are each believed to be routine optimizations to one of ordinary skill, in the absence of unexpected results.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note particularly Merrill, Jr. et al and US 2003/0175503 A1 to Lucast et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is 571-272-1486. The examiner can normally be reached on Monday - Thursday from 8:30 to 6:00. The examiner can also be reached on alternate Fridays

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on 571 – 272 - 1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Daniel Zirker
Primary Examiner
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Daniel Zirker